



01/30/04

3726

HDP/SB/21 based on PTO/SB/21 (08-00)

Please type a plus sign (+) inside this box → ☐

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/862,688
Filing Dat	May 22, 2001
First Named Inventor	D. Mauer et al.
Group Art Unit	3726
Examiner Name	E. Omgba
Attorney Docket Number	0275M-000260/DVB

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Total Number of Pages in This Submission

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): SPR Setting Machine Usage Agreement
Remarks		The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2550. A duplicate copy of this sheet is enclosed.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

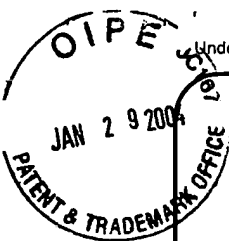
Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name	Monte L. Falcoff	Reg. No.	37,617
Signature					
Date	January 29, 2004				

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail in an envelope addressed to: Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

Typed or printed name	Monte L. Falcoff	Express Mail Label No.	EV 406 075 895 US (1/29/2004)
Signature		Date	January 29, 2004

EV 406 075 895 US



FEE TRANSMITTAL for FY 2004

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 800

Complete if Known

Application Number 09/862,688
Filing Date May 22, 2001
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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money ☐ Other ☐ None
Order

☒ Deposit Account:

Deposit
Account
Number

02-2550

Deposit
Account
Name

The Black & Decker Corporation

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee
to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$) 0

2. EXTRA CLAIM FEES

Total Claims	77	-53 **	=	24	X	18	=	432
Independent Claims	10	-7 **	=	3	X	86	=	258
Multiple Dependent					X		=	0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 690

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	110
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 110

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Monte L. Falcoff	Registration No. Attorney/Agent	37,617	Telephone	248-641-1600
Signature				Date	January 29, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.



- redacted -

SPR SETTING MACHINE USAGE AGREEMENT

RECEIVED
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R3700

This **SPR SETTING MACHINE USAGE AGREEMENT** ("Agreement") is made and entered into as of the last execution date below ("Effective Date"), by and between **EDISON WELDING INSTITUTE**, an Ohio company having an address at 1250 Arthur E. Adams Drive, Columbus, Ohio 43221 (hereinafter, "EWI"), and **EMHART TEKNOLOGIES, INC.** (hereinafter "EMHART"), which is a company organized under the state of Delaware, having a place of business at 49201 Gratiot Avenue, Chesterfield, MI 48051.

In consideration of the promises and the faithful performance of the mutual covenants contained herein, full and sufficient consideration having been provided and the receipt and adequacy of which is acknowledged by EMHART and EWI, the Parties agree as follows:

SECTION 1. DEFINITIONS

1.1 "Affiliate," "Affiliates" and an "Affiliated company" shall mean any subsidiary, joint venture, parent company or corporate entity related to a Party hereto provided that fifty percent (50%) or more of the outstanding shares of the stock in such subsidiary, joint venture, parent company or related corporate entity which is entitled to vote for the election of directors in the case of a stock issuing entity or fifty percent (50%) or more of which in the case of a non-stock issuing entity, is owned or controlled, directly or indirectly, by or of a Party hereto, but only as long as such ownership or control exists.

1.2 "Confidential Information" shall include: all inventions, proprietary information, technical know-how, trade secrets, pending patent applications, computer software, technical drawings, business plans, business information (including the existence, subject matter, and terms of this Agreement), and products, which may be communicated in writing, orally, or by other tangible medium. At least the installation manuals, operation manuals, computer software, and internal components (those hidden from view when fully assembled) of the SPR Machine shall be considered

Confidential Information of EMHART. The following shall not constitute Confidential Information: (a) information which at the time of disclosure to receiving Party by the disclosing Party, was generally and publicly known to a majority in the automotive fastener industry; (b) information which was possessed by receiving Party, as demonstrated by the receiving Party's written or other tangible evidence, before receipt thereof from the disclosing Party; (c) information which is disclosed to the receiving Party in good faith by a third party who has an independent right to such information; or (d) information ordered to be disclosed by a judicial court or governmental administrative agency, with prior notice of such a possible issue being promptly provided to the disclosing Party so it can seek a protective order. These exceptions must be substantiated by the receiving Party through corroborated, written or physical proof, and by clear and convincing evidence, if so requested by the disclosing Party.

1.3 "Licensed Patents" shall mean: (a) U.S. Patent No. 6,276,050 entitled "Riveting System and Process for Forming a Riveted Joint" which issued on August 21, 2001; (b) U.S. Patent No. 6,502,008 entitled "Riveting System and Process for Forming a Riveted Joint" which issued on December 31, 2002; (c) U.S. Patent Application Serial No. 09/862,688 entitled "Riveting System and Process for Forming a Riveted Joint" which was filed on May 22, 2001; and (d) U.S. Patent Application Serial No. 10/300,317 entitled "Riveting System and Process for Forming a Riveted Joint" which was filed on November 20, 2002, which are all assigned to Newfrey LLC, EMHART or one of their Affiliates.

1.4 "Parties" shall mean both EMHART and EWI, and "Party" shall mean EMHART or EWI.

1.5 "SPR Machine" shall mean the self piercing rivet machine, WD810 series or equivalent, made by or on behalf of EMHART.

SECTION 2. LOAN OF EQUIPMENT BY EMHART AND USE BY EWI

2.1 EMHART shall loan the SPR Machine to EWI for a term beginning within thirty (30) days of the Effective Date of this Agreement and naturally terminating two (2) year thereafter, unless the term is terminated earlier as provided for in this Agreement.

2.2 EWI shall only use the SPR Machine for experimental and testing purposes which are non-competitive with EMHART and noncommercial in nature, and only at the EWI address provided for in this Agreement.

2.3 EWI shall not duplicate the SPR Machine or any part thereof.

2.4 EWI shall only use the SPR machine in accordance with an installation or operating manual supplied by EMHART to EWI.

2.5 All title and ownership of the SPR Machine shall remain with EMHART or its Affiliates.

SECTION 3. LICENSE GRANT BY EMHART

3.1 EMHART hereby grants to EWI and EWI hereby accepts from EMHART, upon the terms and conditions specified herein, a license under the Licensed Patents to only use the SPR Machine for the term of this Agreement, but only for the use specified in Section 2.2 of this Agreement.

3.2 EWI agrees that the product covered by all of the claims of the Licensed Patents has exhibited commercial success, is valuable and is a significant improvement in the industry.

3.3 EMHART agrees that it will not use EWI's name to promote its business or products to others, whether through advertising or sales promotion or the solicitation of investors.

SECTION 4. IMPROVEMENTS

4.1 It is expressly understood and agreed that the disclosing party owns the confidential information and does not grant any right, license, privilege or immunity, express or implied, to the receiving party under any Confidential Information patent or proprietary right of the disclosing party.

The receiving party, its employees and its agents agree to maintain confidential any equipment, process or technique that they may be exposed to in the course of development, installation, application analysis, or service and repair, while within the disclosing party's facilities.

The Parties agree that any and all enhancements, improvements, modifications, inventions, ideas, or know-how developed, conceived, or discovered (hereinafter "Improvements")

The Parties will negotiate and mutually agree upon whether patents, patent applications, or any other intellectual property right should be obtained that covers or protects any jointly developed Improvement. If the parties disagree on the desirability of legally protecting the jointly developed Improvements, the party in favor of obtaining the protection may apply for such protection at their own expense, and the other party shall assist in obtaining that protection. In such a situation, the party paying for the protection shall own all rights in the jointly developed Improvements and the opposing party shall have a royalty free non-exclusive, non-assignable (except as part of a sale of the business as a whole) license to use the jointly developed Improvements for their

4.2 The ownership and Improvement licensing rights of this Section 4 shall survive termination of this Agreement.

SECTION 5. CONFIDENTIALITY AND PUBLICATION RIGHTS

5.1 EWI shall use its best efforts to keep the EMHART Confidential Information as confidential, and shall not disclose same outside of EWI and EMHART, except as specifically and explicitly allowed in this Agreement for test result publication purposes only. This confidentiality obligation shall survive termination of this Agreement.

SECTION 6. TERMINATION

6.1 Either Party may terminate this Agreement in writing at any time and for any reason.

6.2 Upon termination, EWI shall immediately cease all use of the SPR Machine and return the SPR Machine and all manuals and other materials provided by EMHART, to EMHART, within thirty (30) days, F.O.B. EMHART's facility in Chesterfield Township, Michigan.

SECTION 7. WARRANTIES AND REPRESENTATIONS

7.1 EMHART represents and warrants that it and/or its Affiliates exclusively owns the entire right, title, and interest in and to the Licensed Patents and SPR Machine, has authority to enter into this Agreement and is free to grant the license and perform its obligations as provided for in this Agreement.

7.2 EWI represents and warrants that it has authority to enter into this Agreement and perform its obligations as provided for in this Agreement, and that the performance by EWI of its duties and obligation hereunder does not violate any prior, existing, and will not violate any future contract, obligation, or understanding that EWI may have or subsequently enter into with another.

7.3 Nothing contained in this Agreement shall be construed as: (a) A warranty or representation by EMHART as to the validity, enforceability, scope or eventual issuance of any patents, including the Licensed Patents; (b) A warranty or representation by EMHART that any use by EWI will be free from infringement of third party patents or other intellectual property rights; (c) Conferring by implication, estoppel or otherwise, upon EWI, any license or other right under any EMHART patent, trademark, trade secret, or know-how except the license expressly granted herein; (d) An obligation by EMHART to bring or prosecute actions or lawsuits against third parties for infringement; or (e) An obligation by EMHART to pay any maintenance, annuity, or other fees due to maintain any patents referenced herein.

SECTION 8.

8.1

SECTION 9. MISCELLANEOUS

9.1 EWI may not transfer, reassign or sublicense any of its rights under this Agreement or to the SPR Machine.

9.2 This Agreement and matters connected with the performance thereof shall be construed, interpreted, applied, and governed in all respects in accordance with the laws of the State of Delaware (without regard to the choice of law provisions thereof).

9.4 This Agreement constitutes the entire agreement between EWI and EMHART with respect to the subject matter hereof and supersedes and replaces all previous negotiations, commitments, verbal discussions, and writings with respect thereto and may not be modified or amended except by a writing duly signed by the authorized representatives of each of the parties.

IN WITNESS WHEREOF, the parties have caused this Agreement to be duly executed by their representatives.

EMHART TEKNOLOGIES, INC.

Edison Welding Institute

By: Christine Yingli Lee

By: [Signature]

Typed Name: CHRISTINE YINGLI LEE

Typed Name: JAMIE BAUER

Officer Title: Director of R&D

Officer Title: MGR. CONTRACTS

Date: January 9, 2004

Date: 4/15/04

(SPR Setting Machine Usage Agreement)